

the U.S. Patent Office permitting these same claims to go through protracted examination and prosecution for two and a half years without raising any issues under 35 U.S.C. § 112, first paragraph.

Applicant herein presents clarifying remarks and respectfully submits that claims 1-8 are in condition for allowance. Further, Applicant respectfully requests favorable reconsideration and the initiation of interference proceedings with U.S. Patent No. 5,553,852 to *Higuchi*.

A. The Examiner's Rejections of Claims 1-8 Under 35 U.S.C. § 112, First Paragraph Has Been Overcome

The Examiner rejected claims 1-8 under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed had possession of the claimed invention.

The proper test for claim support under 35 U.S.C. § 112, first paragraph, is whether the disclosure, as originally filed, reasonably conveys to one skilled in the art that the inventor had possession of the claimed subject matter rather than the presence or absence of literal support. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570 (Fed. Cir. 1985). If the *essence* of the original disclosure supports the new claim limitation, the new claimed feature is not new matter. *In re Wright*, 866 F.2d 422 (Fed. Cir. 1989).

Furthermore, the U.S. Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of unpatentability. Insofar as the written description requirement is concerned, that burden is only discharged by presenting evidence or reasons why persons skilled in the art would *not* recognize in the specification a description of the invention defined by the claims.

Presently, the Examiner has failed to meet the *prima facie* case for unpatentability since the support for the claims, as previously amended, can be found in the present application.

1. Claim 1

The Examiner rejected claim 1 as reciting new subject matter not described in the specification. Specifically, the Examiner stated that:

In claim 1, the lower limit on the core diameter (29 mm), the upper limit on the core specific gravity (1.4), the lower limit of the intermediate layer thickness (1 mm), the upper limit of the specific gravity of the intermediate layer (1.2), the lower limit of the hardness of the intermediate layer (85 on JIS C), and the upper limit of the thickness range of the cover being claimed (3 mm) was not disclosed in the originally filed specification.

As an example the upper limit on the thickness range of the originally disclosed cover was 1.27 mm.

(Office Action, p. 2).

Each of the features identified by the Examiner as "new matter" can be found within the specification of the present application. First, the claimed feature of the center core having a diameter of at least 29 mm can be found on page 35, lines 12-14, where the preferred core has a diameter of about 1.545 inches (i.e., 39.243 mm). Applicant respectfully submits that the specification does not have to explicitly disclose each and every core diameter in the claimed range so long as the claimed subject matter is reasonably conveyed. *Not even close 30% off*

Second, the specific gravity of the core of less than 1.4 can be found in the example on page 39, which shows the diameter of the core to be 1.545 inches (39.243 mm) and a weight of 36.5 grams. This weight and diameter results in a specific gravity of 1.154 (i.e., 36.5 grams/31.642 cm³). The specification is not required to explicitly disclose each and every specific gravity in the claimed range so long as the subject matter is reasonably conveyed.)

Third, the intermediate layer having a thickness of at least 1 mm can be found on page 36, lines 5 and 6 of the present application, where the intermediate or inner cover layer is about 0.100 inches (2.54 mm) to about 0.010 inches (0.254 mm). In the examples, an intermediate or inner cover layer is disclosed having a thickness of 1.7 mm (page 39, line 12).

Fourth, the intermediate layer having a specific gravity of less than 1.2 can be found in Sample E of Table 7 on pages 41-42. Sample E is a 50/50 blend of Iotek 7030 and Iotek 8000 which have specific gravities of 0.96 and 0.594, respectively (see pp. 28 and 29).

Fifth, the intermediate layer having a hardness of at least 85 on a JIS C (Shore C) scale can be found on page 42, line 7, which shows a Shore C hardness of 96. Similarly, while the data on Iotek 959 and Iotek 960 shown on page 15 does not

specifically list the specific gravity, the attached sheet (Exhibit A) shows the specific gravities of ionomers as being 0.920 to 0.990, which is less than the specific gravity of 1.2 as recited in claim 1. Furthermore, the specific gravity of the intermediate or inner cover layer (i.e., 0.920 to 0.990) is lower than the specific gravity of the core. On page 42, line 7, a 50/50 blend of Iotek 959/960 has a Shore C hardness of 98.

Sixth, the cover having a thickness of 1 to 3 mm is disclosed on page 36, lines 7-8, where the outer cover is 0.254 to 1.27 mm. *Not even half*

For these reasons, claim 1 is proper and does not introduce any new matter in the present application.

2. Claim 3

The Examiner rejected claim 3 under 35 U.S.C. § 112, first paragraph, as containing new subject matter that was not described in the specification. Particularly, the Examiner stated that:

In claim 3, there is no basis provided for the applicant's reasoning that the now claimed hardness range of the cores and covers was inherent in the original specification. Without a basis in the original specification the now claimed ranges must be considered new matter.

(Office Action, p. 2).

With regard to the claimed features of a center core having a hardness of 45 to 80 on the JIS C scale and the cover having a hardness of 50 to 85 on the JIS C scale, Applicant respectfully submits that such ranges are inherent from the specification. A center core having a hardness of 45 to 80 on the JIS C (Shore C) scale is a very broad feature. A hardness of 45 to 80 on the JIS C (Shore C) scale nearly includes the entire range of such a scale. Only values at the very low end, i.e., less than 45, or at the high end, i.e., greater than 80, would not be included. However, any value within the large range of 45 to 80 falls within the present claim. Clearly, all of the preferred materials that make up the core in the present application are within such a range. Similarly, the cover having a hardness of 50 to 85 on the JIS C (Shore C) scale is also a very broad range. None of the covers recited in the present specification have a hardness which falls outside of such a broad range. Clearly, the present specification would convey to one skilled in the art that Applicant had possession of the claimed

subject matter, i.e., a hardness of 45 to 80 on the JIS C (Shore C) scale. Therefore, claim 3 is proper and does not introduce new matter into the present specification.

3. Claim 5

The Examiner rejected claim 5 under 35 U.S.C. § 112, first paragraph, as containing new subject matter which was not disclosed in the specification of the present application. Specifically, the Examiner stated that:

In claim 5, the lower limit of the diameter of the center core being claimed (29 mm) was not disclosed in the originally filed specification. The lower limit originally disclosed was 35.052 mm.

(Office Action, p. 3).

The diameter of the center core in the range of 29 to 37 mm is found in the specification when the maximum intermediate or inner cover layer and outer cover thickness are used so that the core of a 1.68 inch ball is 1.38 inches (i.e., 35.052 mm). Applicant duly notes that such a core diameter is preferred. However, the core diameter may change depending on the diameter of the ball. The present specification reasonably conveys to one skilled in the art that Applicant had possession of the claimed subject matter of the center core diameter having a range of 29 to 37 mm. Thus, claim 5 is proper and does not introduce new matter into the present specification.

4. Claim 6

The Examiner, in rejecting claim 6, stated that: "neither the upper or lower limit of the claimed difference in the specific gravity (.5 - .1) was disclosed in the originally filed specification." In the present application, the difference in the specific gravity of the core (1.154) is less than the specific gravity of the intermediate or inner cover layer (0.920 - 0.990), equaling 0.234 to 0.164. Such a range is preferred and clearly falls within the claimed range. Therefore, claim 6 is proper and does not introduce new matter into the present specification.

5. Claim 7

The Examiner rejected claim 7 (defining specific gravity of the golf balls) under 35 U.S.C. § 112, paragraph one, stating that: "neither the upper limit (1.0) nor the lower limit (.9) were disclosed in the originally filed specification." The preferred specific gravity of the intermediate layer as recited in claim 7 can be found in sample E of Table 7, where a 50/50 blend of Iotek 7030/8000 have specific gravities of 0.96 and 0.954, respectively (see pp. 28 and 29), which are within the parameters of claim 7. Since such values are preferred, the claimed range is broader to also include less preferable ranges. Clearly, the present specification reasonably conveys to one skilled in the art that Applicant had possession of the claimed specific gravity in the range of 0.9 to 1.0 even though the specification does not explicitly state such a range. Thus, claim 7 is proper and does not introduce new matter in the present specification.

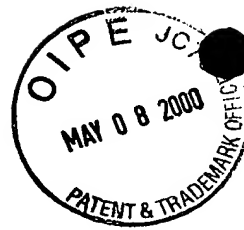
6. Claim 8

The Examiner rejected claim 8 under 35 U.S.C. § 112, paragraph one, stating that: "neither the upper limit (100) nor the lower limit (85) [of the hardness of the intermediate layer] were disclosed" In Table 7, pages 41-42, the intermediate cover preferably has a Shore C hardness of 96 to 98, which clearly falls within the claimed range. Again, although the present specification does not explicitly disclose the ranges, the present specification reasonably conveys to one skilled in the art the claimed range. Thus, claim 8 is proper and does not introduce new matter in the present specification.

Applicants believe that, based upon the disclosure as originally filed, the claims of the present application, as copied from *Higuchi* (U.S. Patent No. 5,553,852) find support therein, either explicitly or inherently. As such, the rejection under 35 U.S.C. § 112, first paragraph, is improper and withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that claims 1-8 are in condition for allowance. Applicant respectfully requests notification of such allowance and the initiation of interference proceedings with U.S. Patent No. 5,553,852 to *Higuchi*. Should any issues remain, the Examiner is encouraged to contact the undersigned



attorney in order to resolve any such issues.

Respectfully submitted,

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DATED: May 4th 2000

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CERTIFICATE OF MAILING

I hereby certify that this **RESPONSE** in connection with U.S. Patent Application Serial No. **08/926,246** is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on May 4th 2000.

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